

Remarks:

Reconsideration of the application is requested.

Claims 1-9 and 11 remain in the application.

In the third paragraph on page 2 of the Office action, claims 1-9 and 11 have been rejected as being obvious over Applicant's Admitted Prior Art (hereinafter "admitted prior art") in view of Salina et al. (U.S. Patent No. 5,340,993) (hereinafter "Salina") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 11 call for, *inter alia*:

the housing having an isolation barrier formed between the two terminal pins.

The Salina reference discloses a semiconductor component having a leadframe mounted within a molded plastic package (19). A light source (18) and an optical detector (28) are each disposed on the leadframe within the package (19). An integral voltage isolation barrier (26) is included in the molded plastic package (19) and is formed between the light source (18) and the optical detector (28). The leadframe (24) includes extensions that protrude from the package (19), which serve as terminal pins for the leadframe (24).

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The reference does not show the housing having an isolation barrier formed between the two terminal pins, as recited in claims 1 and 11 of the instant application.

The Salina reference discloses an isolation barrier disposed between a light source and an optical detector. The Salina reference does not disclose an isolation barrier disposed between terminal pins (the barrier is not disposed between the section of the leadframes (24) which protrude from the housing). The isolation barrier disclosed in Salina serves the purpose of electrically insulating the light source (18) from the optical detector (28) and does not isolate the terminal pins from one another. Since Salina teaches the use of an isolation barrier, formed inside the housing, for isolating the light source from the optical detector, a person of ordinary skill in the art would not find any teaching in

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Salina to provide an isolation barrier between the terminal pins disposed outside of the housing, of the admitted prior art.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v.

Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Salina to incorporate the features of the admitted prior art, and there is no teaching or suggestion in the admitted prior art to incorporate the features of Salina

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ~~ordinary skill in the art would have been led to modify a~~ prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Salina or the admitted prior art or to combine Salina's and the admitted prior art's teachings to arrive at the ~~claimed present invention. Further, the Examiner has not~~ shown the requisite motivation from some teaching, suggestion,

or inference in Salina or the admitted prior art or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements ~~from references to fill the gaps. . . . The references~~ themselves must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Therefore, it is applicants' position that claims 1 and 11 are not obvious over the admitted prior art in view of Salina.

Since claim 1 is believed to be allowable, dependent claims 2-9 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either ~~show or suggest the features of claims 1 or 11. Claims 1 and~~ 11 are, therefore, believed to be patentable over the art and

since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-9 and 11 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

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If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,

Alfred K. Dassler  
52,794

  
For Applicant(s)

AKD:cgm

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Lerner and Greenberg, P.A.  
Post Office Box 2480  
Hollywood, FL 33022-2480  
Tel: (954) 925-1100  
Fax: (954) 925-1101

FAX RECEIVED  
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